

### **REMARKS**

Upon entry of the following amendments, claims 1-2, 4, 6-9, and 11-20 constitute the pending claims in the present application. Claims 3, 5, and 10 were previously cancelled. Claims 1-2, 4, 6-9, and 11-19 stand rejected. Claim 20 is newly added.

#### **Telephonic Interview and Amendments**

Applicants appreciate the time and attention of Examiner Ali during the telephonic interview of May 30, 2008. During the interview, the Examiner indicated that claims reciting a “cone-shaped” feature patentably distinguish over the art of record, e.g., U.S. 5,439,467 to Benderev et al. (“Benderev”). However, the Examiner indicated that such an amendment would not be entered without the filing of a RCE.

Accordingly, Applicants have amended claim 1 and added claim 20 to more particularly define the claimed invention and filed the accompanying RCE for entry of these amendments. In particular, claim 1 has been amended to recite that the blunt tip is “a blunt tip including a solid apex,” and claim 20 has been added and recites that the blunt tip is conical in shape. Applicants submit that the Office’s above conclusions regarding a “cone-shaped” feature apply with equal force to the recited “conical” shaped feature of claim 20. Support for this amendment and for new claim 20 can be found in the application as originally filed, for example, in Figs. 1, 2, and 2A-C. As such, these amendments do not add new matter.

Applicants respectfully request reconsideration in view of the following remarks. Issues raised by the Office will be addressed below in the order they appear in the outstanding Office Action and using the enumeration from the outstanding Office Action.

#### **2.-3. Claim Rejections – 35 U.S.C. 102 – Claims 1-2, 4, 6, and 11-19 over Benderev**

Claims 1-2, 4, 6, and 11-19 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. 5,439,467 to Benderev et al. (“Benderev”). Applicants traverse the rejection to the extent that it is maintained over the claims as currently amended.

The main issue in the present rejection is that the Office and Applicants disagree as to whether Benderev teaches a “blunt tip” as recited in claim 1. In particular, the Office asserts that

the “smooth tapered engaging face 140” at the distal end of the probe guide 125 of Benderev (see column 5, lines 12-13) is a blunt tip (see paragraph spanning pages 2 and 3 of the outstanding Final Office Action). Applicants previously disagreed in the Reply dated November 11, 2007 and asserted (and continue to assert) that the engaging face 140 is not a blunt tip because the probe guide 125 without the sharp tip 120 is hollow and open at its distal end. The Office appears to concede that the probe guide 125 is hollow and open when the sharp tip 120 is not present but still submits that this hollow and open distal end can qualify as a blunt tip “because there is no dictionary definition that supports a blunt tip cannot be hollow” (emphasis added, see middle of first paragraph on page 4 of the outstanding Final Office Action). Applicants respectfully submit that this is incorrect. Dictionary.com provides the following definition for “tip”: the top, summit, or apex: *the tip of the mountain* (see definition #2 in [dictionary.reference.com/browse/tip](http://dictionary.reference.com/browse/tip)). This definition plainly excludes the hollow and open engaging face 140 of Benderev. The engaging face 140 does not include a “summit” or “apex.” It is not like the mountain that dictionary.com uses as an example in defining “tip.” Rather, it is like a volcano, and volcanoes do not have tips; they have lips or rims, which is exactly what Benderev’s hollow and open end of the probe guide 125 has in the absence of sharp tip 120. Geometrically, the device presently claimed terminates distally at a single point (like the peak of a mountain), whereas that of Benderev terminates in a two-dimensional circular shape (like the rim of a volcano), and so the two devices are structurally distinct for at least this reason.

As claim 1 has been amended to recite that the blunt tip includes a “solid apex,” Applicants assert that for this additional reason the hollow and open engaging face 140 of Benderev cannot satisfy the blunt tip feature of claim 1. In particular, the hollow and open engaging face 140 of Benderev cannot include a blunt tip with a solid apex.

Since a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference (see MPEP 2131 quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)), Benderev cannot anticipate claim 1 or those dependent therefrom. As such, Applicants request reconsideration and withdrawal of the rejection.

Regarding claim 19, the Office contends that “the first leg 132C [of Benderev] and the second leg 132A [of Benderev] form an angle of about 90 degrees (fig. 4)” (see end of first whole paragraph on page 3 of the outstanding Final Office Action). Applicants respectfully point out that as the perspective in FIG. 4 of Benderev is from an angle, this figure is not accurate for determining the angle created by segments 132A and 132C. FIG. 2 on the other hand is a direct side profile that is accurate for determining the angle created by segments 132A and 132C. Use of a protractor quickly demonstrates that the angle created by segments 132A and 132C is not about 90 degrees but rather about 120 degrees. Since the devices depicted in FIG. 2 and FIG. 4 are one and the same (see column 2, lines 67-68 of Benderev: “FIG. 4 is a right perspective view of the distal tip of the suture passer illustrated in FIG. 2”), neither of these figures shows that the angle created by segments 132A and 132C is about 90 degrees. Accordingly, the Office has not shown that Benderev teaches or suggests all the features of claim 19, and this reference cannot sustain the novelty rejection over this claim. *Verdegaal Bros. supra*. Applicants request reconsideration and withdrawal of the rejection.

*Withdrawal of Prior Rejections of Record*

The Office is silent regarding the prior rejections of claims 4, 7, 8, 13 and 16 under 35 U.S.C. 112, second paragraph; claims 7-9 under 35 U.S.C. 101 (“same invention” double patenting); and claims 1-2, 4, 6, and 11-19 on the ground of nonstatutory obviousness-type double patenting. Applicants presume that these rejections have been withdrawn and note this with appreciation. However, if this is not the case, Applicants request clarification by the Office.

*Allowable Subject Matter*

Applicants note with appreciation that claims 7-9 have been found allowable. Applicants assert that none of the present amendments or remarks should impact the Office’s indication of allowability for these claims.

*Prior Art Made of Record but Not Relied On*

In the outstanding Final Office Action, the Office cites but does not rely on U.S. 3,372,477 to Hoppe (“Hoppe”). The Office contends that Hoppe “pertains to a blunt tip surgical instrument.” Applicants respectfully disagree and note that the instrument of Hoppe does not include a blunt tip,

and certainly not a blunt tip "including a solid apex." Rather as seen by the combination of FIGs. 1 and 2 of Hoppe, the depicted device includes an edge at its distal end. An edge defines a one-dimensional line, which is distinct from a tip including an apex, which defines a point. Since the presently claimed device terminates at a single point and that of Hoppe at a line, the two devices are structurally distinct for at least this reason.

### **CONCLUSION**

In view of the above arguments and amendments, Applicants believe the pending application is in condition for allowance. Early and favorable reconsideration is respectfully solicited. The Examiner may address any questions raised by this submission to the undersigned at 617-951-7000.

Applicants believe no fee is due with this Reply. However, if a fee is due, please charge our Deposit Account No. 18-1945, under Order No. MIY-P01-011 from which the undersigned is authorized to draw.

Dated: June 13, 2008

Respectfully submitted,

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